NOV 19 1971

IN THE

Supreme Court of the United States

Supreme Court, U.S.
FILED
FEB 22 1971
E. ROBERT SEAVER, CLERK

No. 71-485

ROBERT GOTTSCHALK, Acting Commissioner of Patents,

Petitioner,

v.

GARY R. BENSON and ARTHUR C. TABBOT,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

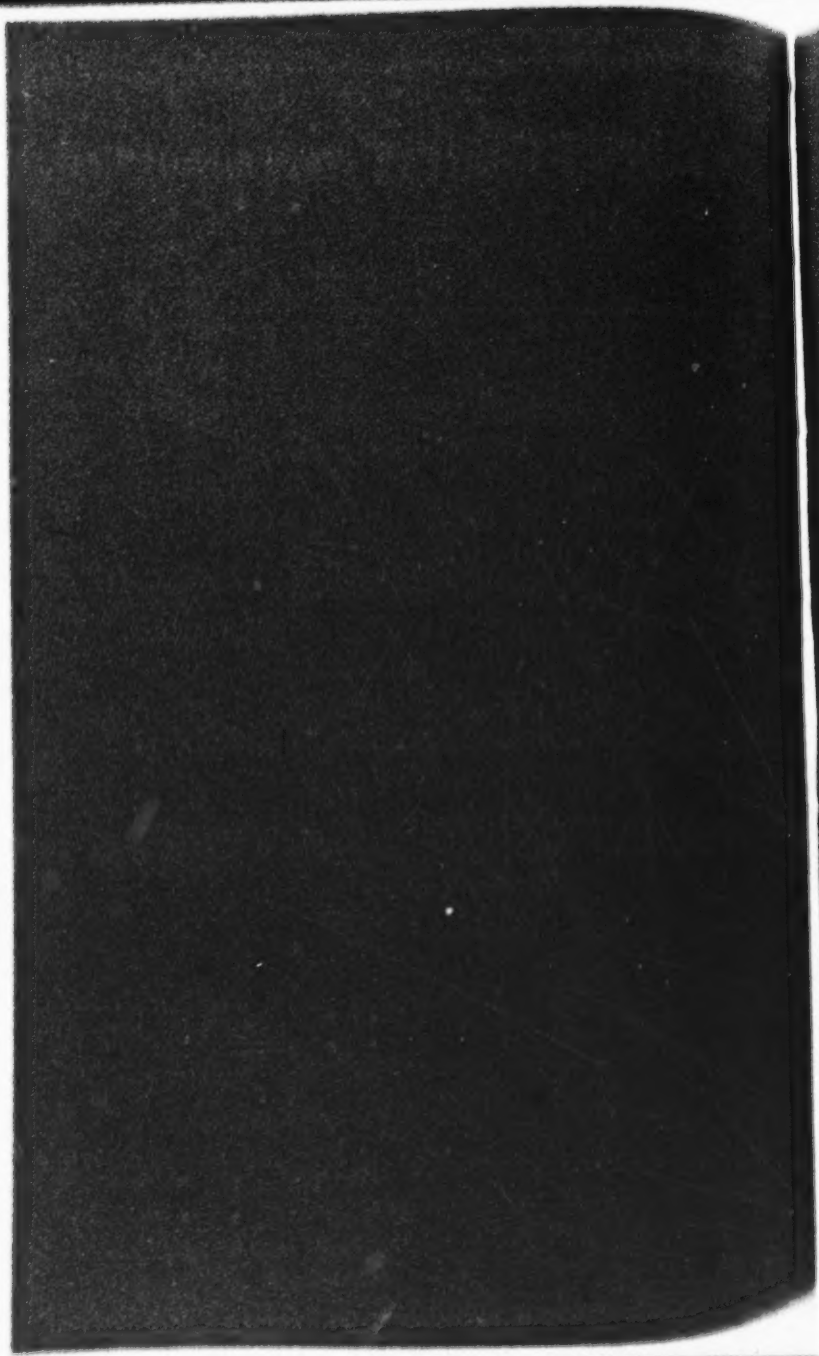
MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE FOR THE INFORMATION INDUSTRY ASSOCIATION

PAUL G. ZURKOWSKI, Esq.
1025 15th Street, N.W.
Washington, D.C. 20005

CHARLES EPHRAIM, Esq.
1250 Connecticut Avenue, N.W.
Washington, D.C. 20036

Attorneys for Amicus Curiae The Information Industry Association

Washington, D. C. · [illegible] PRESS · 202 · 393-0625



IN THE SUPREME COURT OF THE UNITED STATES

No. 71-485

ROBERT GOTTSCHALK, Acting
Commissioner of Patents,
Petitioner,

v.

GARY R. BENSON and ARTHUR C. TABBOT,
Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

The Information Industry Association respectfully moves for leave to file the attached Brief Amicus Curiae in the above-entitled case. Petitioner has consented to the filing of this Brief. Consent has been refused by counsel for respondents.

Applicant respectfully submits that the attached Brief Amicus Curiae will be of assistance to this Court. The reasons that applicant believes its motion should be granted are as follows:

The Information Industry Association was organized in 1968. Its 42 voting and 11 nonvoting members are for-profit organizations concerned with information production, storage, retrieval, processing and distribution. They include many small, relatively young corporations offering specialized services as well as larger publishing and communications firms.[1] Their business products include *inter alia* publications such as indexes, abstracts, citation lists, mail order catalogs, parts lists, price lists, directories, and services such as file searches, searches of current publications, and exhibits or demonstrations for educational, promotional, or merchandising purposes. These businesses depend upon the use of computers to process, store and update information, to search for and retrieve particular pieces of information from all of the information stored, and to assemble and transmit information products from storage.

Computer programs are essential to nearly all of this work. The information industry has experienced rapid growth and great innovation in recent years. Many novel and extremely useful computer programs have been and are being developed within the industry or by suppliers for the use of the industry. The industry is vigorously competitive.

Although computer programs have been written in greatly increasing numbers since 1952[2] and many such programs have been brilliantly innovative, until October, 1969 patent protection was unavailable because the Patent Office had

---

[1] A list of members is attached as Appendix A hereto.

[2] In 1952 John von Neumann and his associates at the Institute for Advanced Study completed the Mathematical Analyzer, Numerical Integrator and Computer (MANIAC I), the first computer capable of using a flexible stored program that could be changed at will. Prior models were wired to perform a specific sequence of calculations and if different calculations were required, the computer had to be extremely rewired. *See* Stanislaw M. Ulam, *Computers, Scientific American*, Vol. 211, No. 3, p. 203 (September, 1964).

taken the position that computer programs were not within the statutory definition of patentable subject matter.[3]

The attached Brief Amicus Curiae deals with the need for resolution by this Court of the basic question of the patentability of computer programs. This subject is not fully treated in the Government's petition.

Accordingly, the Information Industry Association respectfully requests that this Court grant leave to file the attached Brief Amicus Curiae.

Respectfully submitted,

Paul G. Zurkowski, Esq.
1025 15th Street, N.W.
Suite 700
Washington, D.C. 20005

Charles Ephraim, Esq.
1250 Connecticut Ave., N.W.
Suite 600
Washington, D.C. 20036

Attorneys for Amicus Curiae
The Information Industry
Association

---

[3]*See* S. Doc No. 5, 90th Cong., 1st Sess. 21 (1967); Guidelines to Examination of Application for Patents on Computer Programs, 33 Fed. Reg. 15609 (October 22, 1968); Rescission of Guidelines to Examination of Patent Applications on Computer Programs, 34 Fed. Reg. 15724 (October 10, 1969).

APPENDIX A

INFORMATION INDUSTRY ASSOCIATION MEMBERSHIP LIST CORPORATE MEMBERS

ABC-CLIO, INC.
2010 Alameda Padre Serra
Santa Barbara, Cal. 93103

ARCATA NATIONAL CORP.
2750 Sand Hill Rd.
Menlo Park, Cal. 94025

ASPEN SYSTEMS CORP.
4615 Forbes Ave.
Pittsburgh, Pa. 15213

AUERBACH PUBLISHERS, INC.
121 N. Broad St.
Philadelphia, Pa. 19107

BELL & HOWELL MICRO-PHOTO DIV.
Drawer "E"
Wooster, Ohio 44691

CAHNERS PUBLISHING CO., INC.
270 St. Paul St.
Denver, Colorado 80206

C & S PUBLICATIONS, INC.
1900 Ave. of the Stars
Century City
Los Angeles, Cal. 90067

CCM INFORMATION CORP.
866 Third Ave.
New York, N.Y.

CENTER FOR POLITICAL RESEARCH
1730 M Street, N.W.
Washington, D.C. 20036

CONGRESSIONAL INFORMATION SERVICE
4720 Montgomery Lane
Washington, D.C. 20014

FROST AND SULLIVAN
106 Fulton St.
New York, N.Y. 10038

HERNER & CO.
2100 M Street, N.W.
Washington, D.C. 20036

HOLT, RINEHART AND WINSTON
383 Madison Avenue
New York, N.Y. 10038

INFORMATION DESIGN, INC.
3247 Middlefield Rd.
Menlo Park, Cal. 94025

INFORMATION HANDLING SERVICES
P.O. Box 1154
Englewood, Colorado 80110

INSTITUTE FOR SCIENTIFIC INFORMATION
325 Chestnut St.
Philadelphia, Pa. 19106

INTERNATIONAL COMPUTER PROGRAMS, INC.
2511 E. 46th St.
Indianapolis, Indiana 46205

INTERNATIONAL DATA CORP.
60 Austin St.
Newtonville, Mass. 02160

INTERNATIONAL SYSTEMS DESIGN
2175 Lemoine Ave.
Fort Lee, New Jersey 07024

THE LAWYERS CO-OP PUBLISHING CO.
Rochester, New York 14603

LEASCO SYSTEMS & RESEARCH CORP.
LEASCO INFORMATION PRODUCTS, INC.
4833 Rugby Avenue
Bethesda, Maryland 20014

MCGRAW-HILL, INC.
330 West 42nd Street
New York, N.Y. 10036

NATIONAL BUSINESS SERVICES, INC.
NBS Bldg.
Trevose, Pa. 19047

NEW YORK TIMES
229 West 43rd Street
New York, N.Y. 10036

NATIONAL EDUCATIONAL CONSULTANTS, INC.
711 St. Paul St.
Baltimore, Md. 21202

PERGAMON PRESS, INC.
Fairview Park
Elmsford, New York 10523

PHARMACO-MEDICAL DOCUMENTATION
P.O. Box 401
Chatham, New Jersey 07928

PLENUM PUBLISHING CORP.
227 W. 17th Street
New York, N.Y. 10011

PREDICASTS, INC.
200 University Circle
Research Bldg. No. 2
Cleveland, Ohio 44106

RCA CONSUMER INFO. SYSTEMS DEV.
30 Rockefeller Plaza
New York, N.Y. 10020

READEX MICROPRINT CORP.
5 Union Square
New York, N.Y. 10003

RESEARCH PUBLICATIONS, INC.
P.O. Box 3095
New Haven, Conn. 06525

SCANFAX SYSTEMS CORP.
8110 Webb Avenue
N. Hollywood, Cal. 91605

SHOWCASE CORP.
6230 John R. St.
Detroit, Michigan 48202

SRS, INC.
620 Trolley Blvd.
Rochester, New York 14606

TECHNICAL INFORMATION INC.
6331 Hollywood Blvd.
Los Angeles, Cal. 90028

3i COMPANY
2204 Walnut St.
Philadelphia, Pa. 19103

UNIVERSITY COMPUTING CO.
11260 Indian Trail
Dallas, Texas 75229

WESTINGHOUSE TELE-COMPUTER SYSTEMS CORP.
Gateway Center
Pittsburgh, Pa. 15222

JOHN WILEY & SONS
605 Third Ave.
New York, N.Y. 10016

THE H.W. WILSON CO.
950 University Avenue
Bronx, New York 10452

XEROX CORPORATION
1200 High Ridge Road
Stamford, Conn. 06903

GINN & COMPANY
P.O. Box 191
Boston, Mass. 02117

Class II, Non-Voting Members:

EASTMAN KODAK CO.
343 State St.
Rochester, N.Y. 14650

INTERNATIONAL BUSINESS MACHINES
Armonk, N.Y. 10504

INFORMATION RETRIEVAL LTD.
38 Chancery Lane
London WC2A, England

MULTIPRINT, INC.
29 West 23rd St.
New York, N.Y. 10010

NATIONAL CASH
REGISTER CO.
1000 Cox Plaza
3131 S. Dixie
Dayton, Ohio 45439

OCTAL SYSTEMS, INC.
P.O. Box 12632
Ft. Worth, Texas 76116

PUBLICATE, INC.
7758 Wisconsin Ave.
Bethesda, Maryland 20014

ROCAPPI
200 N. Park Drive
Penn Sauken, New Jersey
08109

SEDGWICK PRINTOUT
SYSTEMS CORP.
410 E. 62nd St.
New York, N.Y. 10021

STROUD BRIDGEMAN PRESS LTD.
Toronto Off. Box 6
Post St. R.
Toronto, Ontario

THOMSON DATA LTD.
York House 37 Queen Square
London WC1, England

IN THE SUPREME COURT OF THE UNITED STATES

No. 71-485

ROBERT GOTTSCHALK, Acting
Commissioner of Patents,

Petitioner,

v.

GARY R. BENSON and ARTHUR C. TABBOT,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF AMICUS CURIAE FOR THE INFORMATION INDUSTRY ASSOCIATION

QUESTION PRESENTED

Whether a computer program constitutes patentable subject matter under 35 U.S.C. §101.

Interest of the Information Industry Association

The Information Industry Association was organized in 1968. Its 42 voting and 11 nonvoting members are for-profit organizations concerned with information production, storage, retrieval, processing and distribution. They include many small, relatively young corporations offering

specialized services as well as larger publishing and communications firms. Their business products include, *inter alia*, publications such as indexes, abstracts, citation lists, mail order catalogs, parts lists, price lists, directories, and services such as file searches, searches of current publications, and exhibits or demonstrations for educational, promotional, or merchandising purposes. These businesses depend upon the use of computers to process, store and update information, to search for and retrieve particular pieces of information from all of the information stored, and to assemble and transmit information products from storage.

Computer programs are essential to nearly all of this work. The information industry has experienced rapid growth and great innovation in recent years. Many novel and extremely useful computer programs have been and are being developed within the industry or by suppliers for the use of the industry. The industry is vigorously competitive. The interest of the Information Industry Association is to express the great practical need in the business community for resolution by this Court of the basic question of the patentability of computer programs.

Reason for Granting the Writ

A DEFINITE ANSWER TO THE QUESTION OF THE PATENTABILITY OF COMPUTER PROGRAMS IS NEEDED TO PROVIDE THE BUSINESS COMMUNITY MORE CERTAINTY IN ITS TRANSACTIONS WHICH INVOLVE AND DEPEND ON THE PROPRIETARY STATUS OF COMPUTER PROGRAMS

Section 101 of Title 35 limits patentable subject matter to "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." Respondents assert, and the Court of Customs and Patent Appeals decided, that a computer program is patentable subject matter because it falls within the definition of "process."

The question of the patentability of computer programs is relatively new and has not been settled by this Court. Until October, 1969, the Patent Office followed a policy of rejecting applications for patents on computer programs on the ground that they were not within the categories of patentable subject matter set out in the statute.[1] These rejections brought a series of eight cases on appeal to the Court of Customs and Patent Appeals.[2] Only the *In re Benson* case below considered the question of the patentability of a computer program with no accompanying hardware or machinery that reflected the invention. In 1970, in response to the Court of Customs and Patent Appeals decisions, the Patent Office began issuing patents on computer programs. However this is such a recent development that no infringement litigation has been commenced, of which *amicus curiae* is aware, and no federal district court or circuit court of appeals has decided this question.

In view of the wide variety of approaches being taken within the information industry and the business community generally to the question of proprietary protection for computer programs, the question raised by this case is certain to arise again and again until it reaches this Court. Until the basic question of patentability for computer programs is settled by this Court, the creators and users of computer programs face uncertainty surrounding the proprietary status

---

[1] *See* S. Doc. No. 5, 90th Cong., 1st Sess. 21 (1967); Guidelines to Examination of Application for Patents on Computer Programs, 33 Fed. Reg. 15609 (October 22, 1968); Rescission of Guidelines to Examination of Patent Applications on Computer Programs, 34 Fed. Reg. 15624 (October 10, 1969)

[2] The cases decided prior to this case are: *In re Prater*, 415 F.2d 1378 (C.C.P.A. 1968), *mod on reh.* 415 F.2d 1393 (C.C.P.A. 1969); *In re Wheeling*, 413 F.2d 1187 (C.C.P.A. 1969); *In re Bernhart*, 417 F.2d 1395 (C.C.P.A. 1969); *In re Musgrave*, 431 F.2d 882 (C.C.P.A. 1970); *In re Mahony*, 421 F.2d 742 (C.C.P.A. 1970); *In re Foster*, 438 F.2d 1011 (C.C.P.A. 1971); *In re Benson*, 441 F.2d 682 (C.C.P.A. 1971); *In re McIlroy*, 442 F.2d 1397 (C.C.P.A. 1971)

of computer programs. Uncertainty in this area is undesireable and has an adverse effect on business. Uncertainty inhibits investment in research and development of new products. Uncertainty unduly complicates the marketing of existing products by requiring the parties to a transaction to rely on several alternative, duplicative and coincident proprietary mechanisms. Uncertainty thereby unduly raises the cost of the product to the user. This is a major issue affecting not only the information industry but a major portion of the business community and is deserving of the immediate and detailed attention, presentations and argument it would receive in this case Further, since the Patent Office has begun issuing patents to computer programs, this is likely to be the only opportunity for the Court to consider the broad question of patentability for computer programs. The alternative for the business community is to await piecemeal decisions in other cases arising out of patent litigation between private parties involving more limited questions affecting directly only those private parties. A determination now would provide the business community with more certainty not only with regard to contractual relations in each computer program situation, but also in deciding upon its overall business approach to computer software, its production, marketing and use.

The Government's Petition cites *Graham v. John Deere Co.*, 383 U.S. 1, 18 (1966) to the effect that the resolution of such a major issue through case by case litigation debilitates the patent system. In the view of the information industry, to await litigation on this issue is to debilitate commerce in this major field of human endeavor.

CONCLUSION

The Information Industry Association urges that certiorari be granted.

Respectfully submitted,

Paul G. Zurkowski, Esq.
1025 15th Street, N.W.
Suite 700
Washington, D.C. 20005

Charles Ephraim, Esq.
1250 Connecticut Ave. N.W.
Suite 600
Washington, D.C. 20036

Attorneys for Amicus Curiae The Information Industry Association